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## FACSIMILE COMMUNICATION

**To:** Examiner Davi  
**Fax #:** 571-273-0854  
**Re:** U.S. Patent App. # 09/700,712 Carlin Et Al  
**From:** Richard Fichter  
**Total pages:** 2

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Thank you, BACON & THOMAS, PLLC.

### Message:

We are enclosing sheet 5 as requested. Please let us know if you need any further assistance. Thank you.

**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/EP99/03509

from the strains mentioned in claim 16, the subject-matter of claim 16 appears to be novel.

However, in view of D2, in combination with the facts that neither the method for producing the *thyA*' strains nor the strains themselves are inventive (see paragraphs 4 and 5 of this Item) the subject-matter of claim 16 lacks an inventive step (Article 33(3) PCT).

- 7.2. Furthermore, it has to be mentioned that Claim 16 defines a product by the process with which it is obtained (product-by-process). Applicant's attention is drawn to the fact that the jurisprudence of the member states is not homogenous with respect to this type of claims. Under the EPC novelty would be recognized **only** if the product itself is distinguishable from others in the prior art.

**Re Item VI (certain documents cited)**

1. Certain published documents (Rule 70.10)

Application No Patent No	Publication date (day/month/year)	Filing date (day/month/year)	Priority date (valid claim) (day/month/year)
PCT/CU98/00008	15.07.99	30.12.98	30.12.97

**Re Item VII and VIII (form or content and clarity)**

1. The subject-matter of claim 2 characterised by the expression " $\Delta$  *thyA* strain" is not restricted to strains obtainable by the method of claim 1 but embraces also other mutant strains lacking functionality of the *thyA* gene. This could lead to novelty objections. In order to avoid such objections the mentioned expression should be clearly defined.
2. The expression "essentially" used e.g., in claims 1 and 9 lacks clarity. A definition as given in page 3, I.11-14 used in the claims could overcome said objection.
3. The term "gene nucleotides" used in claim 1 is not clear without a definition of the gene in question (Article 6 PCT).